



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
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Paper No. 8

JAN 12 2001

In re Application of :
Joseph John Tebbe : DECISION ON PETITION
Application No. 09/198,240 :
Filed: November 23 1998 :
For: Clamping Jaw Device :

This is a decision on the petition filed on December 1, 2000 by which petitioner requests withdrawal of the examiner's holding that this application stands abandoned for failure to pay the Issue Fee. No fee is required for the petition, which is treated under 37 CFR 1.181.

The petition is dismissed.

Petitioner alleges that no reply to the Issue Fee was filed because the Notice of Allowance was not received, and in fact no correspondence was received by counsel subsequent to the Office letter dated October 6, 1999. Petitioner supports this allegation with a statement of counsel which explains in detail the manner in which counsel receives and docketes incoming mail, and states that inspection of the docketing records shows that the Notice of Allowance was never received.

It appears from the petition that counsel may not have received the Notice of Abandonment dated August 4, 2000. A copy of this Notice is being attached to this Decision as a courtesy. In view of the fact that the Notice of Abandonment was apparently not delivered, this petition will be considered on its merits notwithstanding that it was filed more than two months after the date of the Notice of Abandonment. However, as discussed below, the issue of the correctness of the correspondence address of record may have some impact on the question of withdrawing the holding of abandonment.

It also appears from the petition that counsel was informed that Office computer records show that he is not attorney of record in this application. That information is erroneous, as Office records clearly show that the attorney of record is Herman H. Bains.

A review of the written record indicates no irregularity in the mailing of the Notice of Allowance, and in the absence of any irregularity there is a strong presumption that the Office action properly mailed to practitioner at the correspondence address of record was in fact delivered. This presumption may be overcome by a showing that the Office action was not in fact received. MPEP § 711.03(c) contains a discussion of the minimum showing required to establish the failure to receive an Office action as originally promulgated by the Notice published at 1156 OG 53. The minimum showing must consist of a statement from the practitioner stating that the Office action was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received. A copy of the docket record where the non-received Office action would have been entered had it been

received and docketed must be attached to and referenced in practitioner's statement.

The showing which accompanies the present petition lacks a copy of the docket record where the Notice of Allowance, dated February 14, 2000, would have been entered had it been received and docketed, and a corresponding reference to the attached copy of the docket record in counsel's statement. Accordingly, the presumption of delivery of properly addressed correspondence has not been overcome, and the showing attached to the petition is inadequate to establish that the Notice of Allowance dated February 14, 2000 was not in fact received.

Further, it is noted that the mailing address on the present petition differs from the record correspondence address of the present application in the application file and in the Office's computer system for this application. The record shows that the Notice of Allowance was returned as undeliverable due to the expiration of a forwarding order. It appears, therefore, that counsel's address may have been changed during the prosecution of this application, and that the change of address may have had an effect on the delivery of the Notice of Allowance dated February 14, 2000. It does not appear that a change of correspondence address has been filed in this application. Accordingly, in addition to supplementing the showing attached to the present petition by including a copy of the docket record in which the Notice of Allowance mailed on February 14, 2000 would have been docketed together with a statement referencing that copy, petitioner is required to discuss whether the change of address would have effected delivery of the Office letter in question. If the address change took effect prior to February 14, 2000, what procedures were utilized to insure that in the absence of a change of correspondence address directed to the instant application, Office letters addressed to the correspondence address of record in this application would be delivered to the new correspondence address? To what extent have those procedures been successful? Did these procedures have an expiration date which would have adversely effected delivery of the Notice of Allowance mailed February 14, 2000?

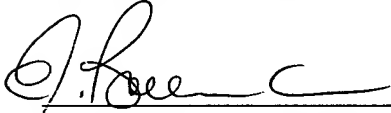
Petitioner is invited to file a renewed petition addressing the matters discussed above. The renewed petition may be filed without fee. The renewed petition must be filed within two months from the date of this Decision, 37 CFR 1.181(f). The renewed petition may be filed by facsimile transmission addressed to the undersigned at (703) 305-3762. Alternatively, the renewed petition can be filed by mail in an envelope addressed to:

Assistant Commissioner for Patents
Washington, DC 20231

with the contents of the envelope directed to the attention of the undersigned in Technology Center 3700. Petitioner is advised that in the event that this application became abandoned as a result of the failure to inform the Office of a change of correspondence address, it may be necessary to file a petition under 37 CFR 1.137 to revive this application.

This application is being retained in Patent Examining Group 3720 pending the filing of a renewed petition, or other appropriate action.

PETITION DISMISSED.



E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

Attachment

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